

REMARKS

Claims 1-34 are pending in the application.

Requirement

Restriction is required under 35 U.S.C. 121 and 372, as the application is asserted to contain the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

- I Claims 1-30 (in part), are drawn to a compound of formula (I) wherein: R⁴ is substituted or unsubstituted phenyl and all other variables are as defined in claims 1, classified in various subclasses in class 548.
- II Claims 1-30 (in part), are drawn to a compound of formula (I) wherein: R⁴ is substituted or unsubstituted pyrrolyl and all other variables are as defined in claims 1, classified in various subclasses in class 548.
- III Claims 1-30 (in part), are drawn to a compound of formula (I) wherein: R⁴ is substituted or unsubstituted piperidinyl and all other variables are as defined in claim 1, classified in various subclasses in class 546.
- IV Claims 1-30 (in part), are drawn to a compound of formula (I) wherein: R⁴ is substituted or unsubstituted morpholino and all other variables are as defined in claim 1, classified in various subclasses in class 544.
- V Claims 31-32 (in part), are drawn to a method of use for compounds of formula (I) wherein: R⁴ is substituted or unsubstituted phenyl and all other variables are as defined in claim 1, classified in various subclasses in class 514.
- VI Claims 31-32 (in part), are drawn to a method of use for compounds of formula (I) wherein: R⁴ is substituted or unsubstituted pyrrolyl and all other variables are as defined in claim 1, classified in various subclasses in class 514.
- VII Claims 31-32 (in part), are drawn to a method of use for compounds of formula (I) wherein: R⁴ is substituted or unsubstituted piperidinyl and all other variables are as defined in claim 1, classified in various subclasses in class 514.

- VIII Claims 31-32 (in part), are drawn to a method of use for compounds of formula (I) wherein: R⁴ is substituted or unsubstituted morpholinyl and all other variables are as defined in claim 1, classified in various subclasses in class 514.
- IX Claims 33-34 (in part), are drawn to a process for preparing a mitotic kinesin Eg5 inhibitor or an antitumor agent using compounds of formula (I) wherein: R⁴ is substituted or unsubstituted phenyl and all other variables are as defined in claim 1, classified in various subclasses in class 514.
- X Claims 33-34 (in part), are drawn to a process for preparing a mitotic kinesin Eg5 inhibitor or an antitumor agent using compounds of formula (I) wherein: R⁴ is substituted or unsubstituted pyrrolyl and all other variables are as defined in claim 1, classified in various subclasses in class 514.
- XI Claims 33-34 (in part), are drawn to a process for preparing a mitotic kinesin Eg5 inhibitor or an antitumor agent using compounds of formula (I) wherein: R⁴ is substituted or unsubstituted piperidinyl and all other variables are as defined in claim 1, classified in various subclasses in class 514.
- XII Claims 33-34 (in part), are drawn to a process for preparing a mitotic kinesin Eg5 inhibitor or an antitumor agent using compounds of formula (I) wherein: R⁴ is substituted or unsubstituted morpholinyl and all other variables are as defined in claim 1, classified in various subclasses in class 514.

The Requirement further states that the above list is not exhaustive and indicates that Applicant may choose either of the following options:

- another specific embodiment not among the above-listed exemplary groups; or
- a specific compound which the Examiner will attempt to group.

The requirement asserts that the inventions listed as Groups I through XII do not relate to a single general inventive concept under PCT Rule 13.1, because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

- The special technical feature of the invention of Groups I through IV are compounds of formula (I) wherein R⁴ are substituted or unsubstituted moieties selected from phenyl, pyrrol, piperidinyl, and morpholino.

- The special technical feature of the invention of Groups V through VIII are methods of use for compounds of formula (I) wherein R⁴ are substituted or unsubstituted moieties selected from phenyl, pyrrol, piperidinyl, and morpholino.

- The special technical feature of the invention of Groups IX through XII are processes for preparing mitotic kinesin Eg5 inhibitors or antitumor agents using compounds of formula (I) wherein R⁴ are substituted or unsubstituted moieties selected from phenyl, pyrrol, piperidinyl, and morpholino.

Election

In order to be responsive to the requirement for restriction, Applicants elect Group I, Claims 1-30 (in part), drawn to a compound of formula (I) wherein: R⁴ is substituted or unsubstituted phenyl and all other variables are as defined in claims 1, with traverse.

Traverse

Notwithstanding the election of Group I in order to be responsive to the requirement for election, Applicants respectfully traverse the requirement for restriction.

Applicants note that this application is a national stage application, and therefore under unity of invention practice the Examiner must establish that the claims lack unity of invention under PCT Rule 13.1 and 37 C.F.R. 1.475.

In particular, the Examiner is reminded that in determining unity of invention, the criteria set forth in 37 C.F.R. 1.475 must be considered. Specifically, Applicants note that 37 C.F.R. 1.475 provides:

Unity of invention before the International Searching Authority, the International Preliminary Examining Authority, and during the national stage.

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

(c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.

(d) If multiple products, processes of manufacture, or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and § 1.476(c).

(e) The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

Thus, in stating the restriction requirement, the requirement must state why unity of invention is lacking under 1.475. In the instant situation, the requirement does not refer to 1.475, and does not indicate that the requirement is proper in view of this rule.

The requirement does point to PCT Rule 13.1 and PCT Rule 13.2, and asserts that the special technical feature of the invention of Group I are compounds of formula (I) wherein R⁴ are substituted or unsubstituted phenyl, which is not present in all other Groups, and that the special technical feature of the invention of Groups, namely compounds, methods of use thereof, or process for preparing compounds of formula (I) wherein R⁴ are substituted or unsubstituted moieties selected from pyrrol, piperidinyl, and morpholino which is not present in Group I. However, the requirement does not discuss 1.475(b)(1) which permits an international or a national stage application containing claims to different categories of invention to have unity of invention if the claims are drawn only to one of the following combinations of categories including a product and a process specially adapted for the manufacture of said product.

Therefore, the requirement for restriction is not proper, and should be withdrawn.

In view of the foregoing, it is respectfully requested that the Examiner reconsider the requirement for restriction, and withdraw the same so as to give an examination on the merits on all of the claims pending in this application.

CONCLUSION

For the reasons discussed above, it is respectfully submitted that the Examiner's requirement for restriction is improper and should be withdrawn. Withdrawal of the requirement for restriction with the examination of all claims pending in this application is respectfully requested. Favorable consideration with early allowance of the pending claims is most earnestly requested.

If the Examiner has any questions, or wishes to discuss this matter, please call the undersigned at the telephone number indicated below.

Respectfully submitted,
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